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REMARKS

This Amendment is submitted in response to the Office Action mailed on April 5, 2007. Claims 1 - 19 are pending, and all stand rejected at present.

Claim 20 is added. No fee is due.

Support for the amendment to claim 17 is found, for example, in the Specification, page 2, lines 7 - 18.

Some amendments to the claims restrict the claims from self-service terminals generally to ATMs specifically. Other amendments more clearly define claim terms, such as the recited "contact information."

RESPONSE TO 103 - REJECTIONS

All claims were rejected as obvious, based on a Smith patent and an EPI article.

References are Non-Analogous Art

Smith concerns a computerized dispatching system, for dispatching taxicabs and ambulances, and perhaps cargo-carrying vehicles such as those used by United Parcel Service and Federal Express.

Smith's system handles problems such as

- 1) determining the location of a person who makes a request for transportation, or a

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pick-up,

2) determining the best vehicle to select for that person, based on factors such as the vehicle's location and whether the vehicle has facilities which may be needed by the person, such as a wheelchair lift, and so on.

EPI is cited as showing an ATM, Automated Teller Machine.

Applicant submits that it is plain that the two references lie in non-analogous arts.

MPEP § 2141.01(a) states:

Analogous and Nonanalogous Art

TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT
MUST BE ANALOGOUS PRIOR ART

. . .

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.
(Citations.)

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.

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(Citations.)

Applicant points out that Smith is clearly not pertinent to Applicant's endeavor, which is to allow (1) a remote party to execute a transaction at an ATM, while (2) another party collects money, or media, delivered by the ATM in the transaction.

Therefore, Applicant submits that the references cannot be combined, because they are non-analogous.

No Expectation of Success Shown

Point 1

No expectation of success has been shown, indicating that the combination of references actually works.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . . .

Second, there must be a reasonable expectation of success.

. . . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

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The PTO has not explained how the ATM machine of EPI is incorporated into the dispatching system of Smith, and what, exactly, is obtained.

For example, the following questions arise:

- If a person telephones Smith's system asking for a taxicab, or ambulance, why would that person need an ATM ?
- What does an ATM actually do in Smith's system ?
- Smith states that an ATM-like device can be used to call a taxicab/ambulance. (Column 3, lines 15, 16.) If Smith's device is an ATM-like device, but not actually an ATM, then what purpose is served by adding the additional functionality of an actual ATM ?

Applicant again asks: What is actually obtained by adding an ATM to Smith ? Where is the expectation of success ?

Point 2

It is well known that ATMs communicate with banks using ATM networks (such as Cirrus (TM)), over a telephone system. However, an outsider cannot gain access to this network, for security reasons.

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That is, an ATM has no "telephone number" in the usual sense, which would allow a random person to call a modem inside the ATM, to make contact with the computer within the ATM.

Smith clearly uses the public telephone system, as well as radio communication to contact his vehicles.

The PTO has provided no explanation of how the highly secure communication of an ATM would, or should, be incorporated into Smith's communication system.

Conclusion

Therefore, for at least the preceding reasons, Applicant submits that no expectation of success has been given, which precludes the combination of the references.

Even if References are Combined, Claimed Invention is not Attained

The Office Action, page 3, sets forth several elements supposedly found in Smith. However, most of those elements do not correspond to the elements claimed.

Further, several claim recitations do not appear in that group of elements supposedly found in Smith. These missing recitations include the following.

Missing Recitations - Part 1

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As background, Applicant points out that, in one form of the invention, an ATM contacts an ATM customer, as by calling the customer's cell phone. (Specification, page 3, lines 3, 4.) The customer then enters transaction data, such as a PIN and a request for a cash amount, using the cell phone. (Page 2, lines 1 - 3.) However, the customer is not present at the ATM, but another party is present, who collects the cash at the ATM. (Page 2, lines 8 - 10.)

The ATM obtains the telephone number needed to call the customer prior to making the call. (Page 2, line 23.) This step explains the following claim recitations.

Claim 1, and its dependents, recites "means for obtaining contact information for a communications device associated with a user."

Claim 5 recites "means for obtaining a telephone number for a telephone associated with a user."

Claim 6, and its dependents, recite "means for obtaining contact information for a communications device associated with an ATM customer."

Claim 10 recites "means for obtaining a telephone number for a telephone associated with an ATM customer."

Claim 11 recites "means for obtaining contact information for a communications device associated with a user."

Claim 12, and its dependents, recite "obtaining contact

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information for a communications device associated with the identified user."

Claim 16, and its dependents, recite "obtaining contact information for a communications device associated with the identified ATM customer."

The Office Action has not identified these claim recitations in the references. MPEP § 2143.03 states:

To establish prima facie obviousness . . .
all the claim limitations must be taught or suggested by the prior art.

Applicant requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify the recitations identified above in this section.

Missing Recitations - Part 2

Claim 6, and its dependents, recite "means for obtaining contact information for a **communication device associated with an ATM customer.**"

Claim 10 recites "means for obtaining a telephone number for a **telephone associated with an ATM customer.**"

Claim 16, and its dependents, recite "obtaining contact information for a **communications device associated with the identified ATM customer.**"

The Office Action has not identified any "ATM customer," as

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claimed, in the references, nor the claimed "telephone" or "communications device" associated with that "ATM customer."

Applicant requests that these recitations be identified in the references.

Missing Recitations - Part 3

Claim 6, and its dependents, recite "means for controlling the cash dispenser to dispense cash when the entered ATM transaction requires cash to be dispensed."

Claim 10 recites "means for controlling the cash dispenser to dispense cash when the entered ATM transaction requires cash to be dispensed."

Claim 16 recites "(c) establishing a link with the communications device associated with the ATM customer to allow the ATM customer to enter the desired transaction."

Applicant points out that these recitations, within their contexts, state that the customer using the "communications device" or "telephone" is executing the transaction.

These three recitations have not been shown in the references, even if combined. Applicant requests that these recitations be identified.

Missing Recitations - Part 4

Claim 18 states that a link is established between an ATM

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and a "communications device" of an "ATM customer." No "link" nor "communications device" have been shown in the references.

A similar comment applies to claims 8, 9, 17 and 19.

Missing Recitations - Part 5

Claim 17 states that two persons are involved, one using the communications device and the other collecting money at the ATM. That is not seen in the references, even if combined.

No Support of "Inherency" Given - Part 1

The Office Action asserts the following:

- It is inherent that the system of Smith knows the location of the terminals. (Page 3, eleventh line from bottom.)
- It is implicit in Smith that the operator "would select the appropriate service." (Page 3, seventh line from bottom.)
- It is implicit that, in Smith, a confirmation is sent back to the ATM. (Page 3, fourth line from bottom. The undersigned attorney sees no ATM in Smith.)

Applicant points out that MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

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In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Applicant sees no "basis in fact" or "technical reasoning" as required by this MPEP section.

No Support of "Inherency" Given - Part 2

In the preceding section, Applicant pointed out that the Office Action asserted that it is implicit in Smith that the operator "would select the appropriate service." (Page 3, seventh line from bottom.)

Applicant points out that this interpretation of Smith is **directly contrary** to Smith's explicit teachings.

Smith states, at column 2, line 38 et seq.:

It is the object of the present invention
. . . [to provide]

**a fully automated dispatching system which
. . . ELIMINATES THE HUMAN DISPATCHER . . .**

Therefore, since one element of the PTO's line-of-reasoning is plainly incorrect, the entire line-of-reasoning must fail.

No Teaching Given for Combining the References - Part 1

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The rationale given for combining the references appears at the top of page 4 of the Office Action.

Point 1

That rationale, in essence, merely asserts that "ATMs are . . . ubiquitous" and therefore they provide "extensive access" to their "services." Of course, if the ATMs are "ubiquitous," then they necessarily provide "extensive access," because they are everywhere. That is, the "extensive access" is just another way of stating that the ATMs are "ubiquitous."

Thus, the rationale, in essence, merely states that the ATMs in the reference are "ubiquitous."

That rationale, as a matter of logic, does not lead to a combination of the references. That rationale merely sets forth a characteristic of ATMs within the EPI reference.

A characteristic of an element in a reference, in general, is not a teaching for combining that reference with another reference.

Point 2

The rationale implicitly teaches against the combination of references, which modifies the ATMs of EPI.

The reason is that the rationale states that "ATMs are . . . ubiquitous" and therefore they provide "extensive access" to

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their "services." The rationale thus implies that this is a desirable situation.

Modifying those ATMs will modify this situation, contrary to the implicit assumption made by the rationale. That is, if the ATM are now equipped to somehow allow Smith's users to

- 1) order taxicab service,
- 2) call ambulances,
- 3) request package pick-up,
- 4) and so on,

then the workload of the ATMs has been increased.

Under the increased workload, the ATMs can no longer provide their previous services as extensively.

Thus, as a matter of logic, if the goal is to allow the ATMs to provide their "extensive" financial "services," one would not modify them to provide additional services, in connection with Smith's system (even assuming that to be possible).

No Teaching Given for Combining the References - Part 2

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

. . .

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(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The "modifications" which must be applied to the prior art, in order to attain the claimed invention, have not been set forth by the Office Action, as required by this MPEP section.

The "explanation" or "teaching" or "suggestion" for making these modifications have not been set forth, as required.

And the "explanation" etc. have not been shown in the prior

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art, as required.

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


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